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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/480,520 01/07/00 ANDERSEN

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MMC2/1009

EXAMINER

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GONZALEZ, M	
ART UNIT	PAPER NUMBER

2859

DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/480,520

Applicant(s)

ANDERSEN, DEREK

Examiner

Madeline Gonzalez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's amendment dated July 17, 2001

Drawings

1. The drawings are finally objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the housing as stated in claim 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 12, and 15-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Sommer (U.S. 3,006,273) in view of Dunn (U.S. 4,176,458).

Sommer discloses a rotary spacer, as shown in Fig. 1, having:

- a handle 18 including a tubular base member having a forked construction 19 (pair of prong-like members) spaced apart and integrally extending from a bottom end thereof; and

a means for marking including a wheel rotatably mounted to said base member and being extended between said forked construction 19 (pair of prong-like members), said wheel having a perimeter for rolling on a ground surface, said means including a container 20 (marker device) mounted on said wheel and having a marking end positioned at the circumference of said wheel such that said marking end contacts the ground surface as said wheel is rolled on the ground surface and said marking end marks the ground surface with marks spaced at a distance substantially equal to an extent of the circumference of said wheel;
- said means for marking includes an axle member 12 securely and centrally attached to either side of said wheel and being adapted to being retained in said base member;
- said wheel includes a bore radially extending inwardly from the circumference of said wheel and receiving said container 20 (marker device);
- said wheel is mounted on said base member, and said means for marking includes a pin 24 that allows a coil spring to expand to bring the pin 24 to one of a plurality of holes 25 in order to change the diameter of the wheel.

The recitation “a stud marking device” in the preamble of the claims, has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation

where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Sommer lacks a plurality of telescopic members, the specific connection between the wheel and the prong-like members, a plurality of wheels, and the specific measure of the circumferential extent of each of the plurality of wheels.

With respect to the plurality of telescopic members: Dunn discloses a distance measuring apparatus having a handle element 12 (first tubular member) having a plurality of holes 20 spaced therealong and extending through a wall thereof, said handle element 12 (first tubular member) being slidably and lockingly extended in a handle element 14 (base member). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the handle in the device disclosed by Simpson with telescopic members as taught by Dunn in order to provide means for adjusting the handle to different extended positions to reach a desired placed for making a measurement. Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide more telescopic members in order to increase the length of the handle and reach far places, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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With respect to the specific connection between the wheel and the prong-like members: Sommer as modified by Dunn disclosed a device having means for marking including a wheel rotatably mounted to a base member and being extended between a forked construction 19 (pair of prong-like members), said means for marking including an axle member 12 securely and centrally attached to either side of said wheel and being adapted to being retained in said base member, said wheel including a bore radially extending inwardly from the circumference of said wheel and receiving a container 20 (marker device). The specific connection between the wheel and the prong-like members claimed by applicant, i.e., said base member further includes a pair of slots each of which extends in a bottom end respective one of said prong-like members; an axle member securely and centrally attached to either side of said wheel and being adapted to being removably retained in said slots in said base member; and said wheel removably receiving said marking device, absent any criticality, is only considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non – obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the wheel is connected between the prong-like members as already suggested by Sommer as modified by Dunn, 2) the connecting means claimed by applicant and the connecting means used by Sommer as modified by Dunn are well known alternate types of connecting means which will perform the same function, if one is replaced with the other, of connecting the wheel between the prong-like members, and 3) the use of these particular types of connecting means by applicant is considered to be nothing more than the use of one of numerous and well known alternate types of connecting means that a person having ordinary skill in the art

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would have been able to provide using routine experimentation in order to connect the wheel between the prong-like members as already suggested by Sommer as modified by Dunn.

With respect to the plurality of wheels and the specific measure of the circumferential extent of each of the plurality of wheels: Sommer as modified by Dunn disclosed a device having a wheel, said wheel is mounted on a base member, and having means for marking including a pin 24 that allows a coil spring to expand to bring the pin 24 to one of a plurality of holes 25 in order to change the diameter of the wheel. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Sommer as modified by Dunn with a plurality of wheels since it is considered to be an alternate means for changing the diameter of the wheel in order to varying the distances measured, as already suggested by Sommer as modified by Dunn. Furthermore, the specific measure of the circumferential extent of each of the plurality of wheels claimed by applicant, i.e., 16, 12, 24, 18 and 6 inches, absent any criticality, is only considered to be the "optimum" measure of the circumference of the wheel disclosed by Sommer as modified by Dunn that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See In re Boesch, 205 USPQ 215 (CCPA 1980).

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4. Claims 7, 9-11, and 14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Sommer (U.S. 3,006,273) in view of Dunn (U.S. 4,176,458), Simpson (U.S. 4,377,850), Edgar et al. (U.S. 5,884,240) [hereinafter Edgar] and Kaufman (U.S. 5,416,978).

Sommer discloses a rotary spacer, as shown in Fig. 1, having:

- a handle 18 including a tubular base member having a forked construction 19 (prong-like members) spaced apart and integrally extending from a bottom end thereof; and
- means for marking including a wheel rotatably mounted to said base member and being extended between said forked construction 19 (prong-like members).

The recitation “a stud marking device” in the preamble of the claims, has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Sommer lacks a plurality of telescopic members, a housing, marker triggering members, and the specific spacing between the marker-triggering members, the computer means, the specific type of computer means and a spring-loaded marker.

With respect to the plurality of telescopic members: Dunn discloses a distance measuring apparatus having a handle element 12 (first tubular member) having a plurality of holes 20 spaced therealong and extending through a wall thereof, said handle element 12 (first tubular member) being slidably and lockingly extended in a handle element 14 (base member). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the handle in the device disclosed by Simpson with telescopic members as taught by Dunn in order to provide means for adjusting the handle to different extended positions to reach a desired placed for making a measurement. Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide more telescopic members in order to increase the length of the handle and reach far places, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to the housing, the computer means, and the marker triggering members: Simpson discloses a measuring device, as shown in Fig. 1, having a roller 15 (wheel), a calculating unit 11 including an extended portion extending outwardly from a pair of brackets 13 and 14 (prong-like members) and including a housing 12; said calculating unit 11 including a keyboard (keypad) and a display; said roller 15 (wheel) having a plurality of undulations 16 spacedly disposed upon one side of said roller 15 (wheel); said plurality of undulations 16 being essentially rib-like members extending radially of said roller 15 (wheel). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Sommer as modified by Dunn by adding a housing with

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computer means and rib-like members, as taught by Simpson in order to provide means to electronically processed the measuring operations.

With respect to the specific spacing between the marker-triggering members: Sommer as modified by Dunn and Simpson disclosed a measuring device having a roller (wheel), said roller (wheel) having a plurality of undulations 16 (rib-like members) spaced at some distance. The specific spaced claimed by applicant, i.e., approximately one inch, absent any criticality, is only considered to be the "optimum" spaced of the rib-like members disclosed by Sommer as modified by Dunn and Simpson that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See In re Boesch, 205 USPQ 215 (CCPA 1980).

With respect to the specific type of computer means claimed by applicant, i.e., an LCD display; a microcontroller including a read only memory; an LCD driver; and an IR transmitter and IR receiver: Sommer as modified by Dunn and Simpson disclosed a device having a wheel and means for marking including computer means. Edgar discloses an apparatus, as shown in Fig. 1, having an on-board computer module 44, said computer including a LCD display (see col. 30, lines 3-6), a microcontroller including read only memory (see col. 26, lines 34-38), a line driver / receiver (see col. 7, lines 32-35) and a transmitter (see col. 3, lines 52-54). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the calculator unit in the device disclosed by Sommer as modified by Dunn and Simpson with a computer as taught by Edgar in order to have means for storing the data when

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the device is used for making measurements. Furthermore, with respect to the specific type of driver, transmitter and receiver claimed by applicant, i.e., and LCD driver an IR transmitter and an IR receiver, absent any criticality, are only considered to be nothing more than a choice of engineering skill, choice or design because LCD drivers, IR transmitters and IR receivers are well known in the art and neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as a driver, a transmitter and a receiver are used as already suggested by Sommer as modified by Dunn, Simpson and Edgar.

With respect to the spring-loaded marker: Kaufman discloses a marking device 10 as shown in Fig. 7, having means for marking a location including a spring loaded-marker 44 disposed within a housing 12 and is adaptable to extend and retract within an opening 16 (bore). Kaufman teaches a mechanism that operates as follows: when a first engaging member 24 passes over a shaft 70, a linkage mechanism is activated and the marker 44 is released. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Sommer as modified by Dunn, Simpson and Edgar with a marking means as taught by Kaufman in order to provide an alternate means for marking the specific distance measured.

Response to Arguments

5. Applicant's arguments with respect to claims 1-7, 9-12 and 14 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's argument that "the relationship of the marking device to the circumference of the wheel permitting a mark to be placed on the ground at desired spacings, is not shown or suggested by the prior art": Sommer is disclosing a rotary spacer having a marking device and a wheel, and the relationship of the marking device to the circumference of the wheel permits a mark to be placed on the ground at desired spacings.

With respect to applicant's argument that the claimed invention requires a plurality of wheels that permits the replacement of the wheel with a wheel having a circumference corresponding to the desired spacing between the marks: Sommer disclosed a device having a wheel, said wheel is mounted on a base member, and having means for marking including a pin 24 that allows a coil spring to expand to bring the pin 24 to one of a plurality of holes 25 in order to change the diameter of the wheel. To have a plurality of wheels is considered to be an alternate means for changing the diameter of the wheel in order to varying the distances measured, as stated in paragraph 3 above.

With respect to applicant's argument that "the relationship of the housing to a ground surface maintained by the wheel, which permits the marking of the ground surface in an ongoing manner at the selected distances, without having to lift, readjust, or otherwise bother with the

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marking apparatus” is not suggested by the prior art: Sommer discloses a device having a wheel that can roll over a ground surface, said wheel including a marker device which permits the marking of the ground surface in an ongoing manner at selected distances. Therefore, to add a housing as taught by Simpson would not change the marking of the ground surface since the device disclosed by Sommer already has that requirement.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gorfu discloses a distance measuring device having a wheel and a digital display. O'Malley discloses an apparatus for marking on a material. Terrigno discloses an instrument having a wheel and a marking device. Eberhardt, Pearson, and Wheeler disclosed marking devices having a wheel and a marking means.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (703) 308-7004. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MG
October 4, 2001


Diego F.F. Gutierrez
Supervisory Patent Examiner
Technology Center 2800